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| 09/426,954      | 10/26/1999  | EUGENE AUGUST FUSZ   | 10209-00007         | 2561             |

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EXAMINER

BOYCE, ANDRE D

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
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3623

DATE MAILED: 06/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/426,954

Applicant(s)

FUSZ, EUGENE AUGUST

Examiner

Andre Boyce

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 09 April 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Response to Amendment***

1. This Final Office Action is in response to the amendment filed April 9, 2002. Claims 1, 7, 8, 16, 19, and 20 have been amended. Claim 18 has been cancelled. Claims 1-17 and 19-28 are pending.
2. The previously pending objections to the drawings is withdrawn.  
The previously pending rejection to claim 7 under 35 U.S.C. 112 is withdrawn.
3. Applicant's arguments filed April 9, 2002 have been fully considered but they are not persuasive. Further, Applicant's arguments with respect to claims 1-17 and 19-21 have been considered, but are moot in view of the new ground(s) of rejection, based on the amendments to independent claims 1, 8, and 16. Rejections to claims 22-28 have been maintained.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 22-26, and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Goldhaber et al, U.S. Patent No. 5,855,008.

As per claim 22, Goldhaber et al disclose a system for generating and controlling anonymous data sets via an electronic data communications network (overall environment, see column 9, lines 33-36), comprising a control unit for coupling to the communications network (consumer computers with software agents, see column 9, lines 53-56), a server (servers/attention brokers 106, see column 9, lines 37-38 and 62-63) coupled to the control unit comprising a consumer generated database for storing information related to consumer, a marketer database for storing information to be reviewed by consumers, and a processor programmed (software agents 110, see column 9, lines 53-61) to

receive consumer generated data sets controlled by the consumers, each data set including a set of individual characteristics, the processor further programmed to download the consumer generated data sets into the consumer generated database (see column 13, lines 28-30), receive controlled information from marketers, the processor further programmed to download marketer generated data into the marketer database (see column 16, lines 26-29), compare the marketer generated data set to consumer generated data set, designating the marketer generated data set to be communicated to the consumer, if the marketer generated data set is identified as matching one or more of the individual characteristics of the consumer generated data set (see column 16, lines 30-35).

As per claim 23, Goldhaber et al disclose the processor programmed to communicate designated marketer generated data to the consumer if the consumer chooses to view the data (see column 14, lines 53-60).

As per claim 24, Goldhaber et al disclose the processor programmed to communicate the consumer generated feedback of the designated marketer generated data to the marketer (see column 17, lines 4-9).

As per claim 25, Goldhaber et al disclose the processor further programmed to prevent the marketers from accessing the consumer generated data sets (see column 14, lines 18-20).

As per claim 26, Goldhaber et al disclose the processor further programmed to accept consumer generated data sets from the consumer if a correct password is received (see column 16, lines 58-63).

As per claim 28, Goldhaber et al disclose the electronic data communications network comprising the Internet (see column 9, lines 33-35).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-17, and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber et al, in view of ***Dedrick***, U.S. Patent No. 5,717,923.

As per claim 1, Goldhaber et al disclose a method for generating an anonymous data profile of an individual (see column 6, lines 40-44), comprising the steps of administering a password (see column 13, line 22), utilizing the password to access a database (see column 16, lines 58-63), entering ***profile*** information about the individual in the database (consumer database, see column 12, lines 39-42), and storing the ***profile*** information in the database (see column 13, lines 28-30). Goldhaber et al does not explicitly disclose ***refusing to***

***accept contact information from the individual.*** ***Dedrick*** discloses compiling user information except for information that identifies a particular individual (see column 7, lines 27-30). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include refusing to accept contact information from the individual in the Goldhaber et al method, as seen in ***Dedrick***, thus providing complete privacy for the individual, thereby increasing the number of consumers that would otherwise be reluctant to use a method which requires identifying information.

As per claim 2, Goldhaber et al disclose allowing the individual to choose a multi-character identifier (see column 13, lines 24-26).

As per claim 3, Goldhaber et al disclose asking the individual a plurality of questions (profile questionnaire, see column 13, lines 32-35).

As per claim 4, Goldhaber et al disclose communicating with the individual via the password (see column 16, lines 58-63).

As per claim 5, Goldhaber et al disclose asking the individual for the multi-character identifier (password, see column 16, lines 58-63). The password in the Goldhaber et al method is inherently a multi-character identifier.

As per claim 6, Goldhaber et al does not explicitly disclose asking the individual at least one personal question, wherein the individual is permitted to enter the database only if the correct multi-character identifier is given and if at least one of the questions is answered correctly. However, Goldhaber et al disclose asking a personal question (profile, see column 13, lines 60-67).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include requiring the correct multi-character identifier along with correctly answering at least one personal question in the Goldhaber et al method, in order to positively identify the individual attempting to use the method, thereby increasing the overall integrity and security of the method.

As per claim 7, Goldhaber et al disclose **contact information including at least one of** a name, a social security number, **a telephone number**, and an address (see column 13, lines 1-13).

As per claim 8, Goldhaber et al disclose a method for providing advertising feedback (see column 10, lines 44-53, where interacting with the information inherently includes providing feedback), comprising the steps of administering to each individual a password (see column 13, line 22), utilizing the password to access a database (see column 16, lines 58-63), entering **profile** information about the individual in the database (consumer database, see column 12, lines 39-42), storing the entered **profile** information in the database (see column 13, lines 28-30), presenting at least one of the individuals with a set of **data**, and receiving feedback regarding the set of **data** (see column 10, lines 44-53, where interacting with the information inherently includes providing feedback).

Goldhaber et al does not explicitly disclose **refusing to accept contact information from the individual**. **Dedrick** discloses compiling user information except for information that identifies a particular individual (see column 7, lines



27-30). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include refusing to accept contact information from the individual in the Goldhaber et al method, as seen in **Dedrick**, thus providing complete privacy for the individual, thereby increasing the number of consumers that would otherwise be reluctant to use a method which requires identifying information.

As per claim 9, Goldhaber et al disclose presenting each individual with a second set of information generated by an advertiser (see column 10, lines 44-46).

As per claim 10, Goldhaber et al disclose communicating the feedback in aggregate form (through the attention broker in the Goldhaber et al method) to the advertisers (see column 17, lines 4-9).

As per claim 11, Goldhaber et al disclose allowing each individual to choose a multi-character identifier (see column 13, lines 24-26).

As per claim 12, Goldhaber et al disclose asking the individual a plurality of questions (profile questionnaire, see column 13, lines 32-35).

As per claim 13, Goldhaber et al disclose paying the individuals for their feedback (see column 10, lines 46-53).

As per claim 14, Goldhaber et al disclose separating the first set of information from the second set and ensuring the advertisers do not obtain the first set information (see column 14, lines 18-20).

As per claim 15, Goldhaber et al disclose presenting each individual with a second set of information that is specific to the first set of information (consumer profile) provided by the individual (see column 14, lines 30-34).

As per claim 16, Goldhaber et al disclose an apparatus for conveying and storing information relating to anonymous data profiles (see column 6, lines 40-44), comprising a first data repository, a first computer linked to the first data repository (see column 12, lines 39-42), configured to communicate with the first data repository via a password (see column 13, line 22), provide a first set of information about the individual to the first data repository (see column 13, lines 28-30), and a processor programmed to communicate with the first data repository and the first computer (software agents 101, see column 9, lines 53-56). ***Goldhaber et al disclose a second data repository, a second set of computers linked to the second data repository, the second set of computers configured to provide a plurality of second sets of information to the second data repository (servers 106, see column 9, lines 62-67), the first data repository separate from the second data repository, the processor (software agents 110) further programmed to communicate with the second data repository and the second set of computers (see column 9, lines 58-61).*** Goldhaber et al do not disclose the first set of information lacking information relating to a name, an address, ***a telephone number***, and a social security number of the individual. ***Dedrick*** discloses compiling user information except for information that identifies a particular individual (see column 7, lines

27-30). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include refusing to accept contact information from the individual in the Goldhaber et al method, as seen in **Dedrick**, thus providing complete privacy for the individual, thereby increasing the number of consumers that would otherwise be reluctant to use a method which requires identifying information.

As per claim 17, Goldhaber et al disclose the processor (software agents 101) further programmed to store the first set of information from the first computer, if the correct password is provided by the first computer (see column 16, lines 58-63).

As per claim 19, Goldhaber et al disclose the second set of computers (servers 106) not being able to access the first data repository (see column 14, lines 37-39).

As per claim 20, Goldhaber et al disclose the processor (software agents 110) further programmed to screen the second set of information and grant access to the screened second set of information by the first computer (consumer computer 104) if the screened second set of information includes at least one attribute compatible with at least one attribute in the first set of information (see column 14, lines 53-56).

As per claim 21, Goldhaber et al disclose the first computer (consumer computer 104) being configured to access the screened second set of information stored in the first data repository (see column 15, lines 34-37).

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8. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber et al.

As per claim 27, Goldhaber et al do not disclose the consumer generated data sets excluding the name, address, and social security number of the consumer. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to exclude this information in the Goldhaber et al method, in order to guarantee the anonymity of the individuals in the system, thereby increasing the number of consumers that would otherwise be reluctant to use a system which requires identifying information.

### ***Response to Arguments***

9. In the remarks, the Applicant argues (1) in reference to claim 22, that Goldhaber et al do not teach nor suggest a system which is programmed to build (generate) data sets as described, but teach away from the methods recited, since Goldhaber et al recite that an advertiser may pay for consumer names and addresses; (2) in reference to claim 16, that Goldhaber et al do not teach or suggest keeping the first data repository separate from the second data repository; and (3) a request for reconsideration of the amended claims in light of the Written Opinion and IPER rendered by the PCT Examining Authority.

In response to Applicant's argument that (1) in reference to claim 22, Goldhaber et al do not teach nor suggest a system which is programmed to build

(generate) data sets as described, but teach away from the methods recited, since Goldhaber et al recite that an advertiser may pay for consumer names and addresses, the Examiner respectfully reasserts that the rejection indeed teaches all the limitations of the claim, as cited. Further, Goldhaber et al does not teach away from method of claim 22, but states several times that the consumer profile does **not (emphasis)** have to include contact information (see column 13, lines 38-40 and column 14, lines 9-12).

With regards to Applicant's argument that (2) in reference to claim 16, Goldhaber et al do not teach or suggest keeping the first data repository separate from the second data repository, the Examiner submits that consumer computers 104(N) are separate from the information servers 106 (N), and may only communicate via software agents 110(N) (see Figure 1).

With regards to the (3) Applicant's request for reconsideration of the amended claims in light of the Written Opinion and IPER rendered by the PCT Examining Authority, the Examiner has considered the Applicant's request, but maintains the rejections for the following reasons.

First, claim 16 (as amended) of the present application, corresponds to claim 16 of the PCT application, not claim 18 as the Applicant asserts. Further, claim 16 of the PCT application was rendered as **not** having inventive step over Smolen, U.S. Patent No. 5,915,243 in view of Dedrick, U.S. Patent No. 5,717,923.

With regards to claims 19-28, the Examiner submits that although Goldhaber et al was cited in the IPER, it was never used in the analysis of whether the claims were novel and/or had inventive step. Further, the Examiner also submits that by using Goldhaber et al as the primary reference for rejection of the claims (as amended) in this current U.S. application, the analysis is completely different from that used by the PCT Examining Authority.

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andre Boyce whose telephone number is (703) 305-1867. The examiner can normally be reached on 9:30-6pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and After Final communications, and (703) 746-7305 for informal/draft communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



adb  
June 19, 2002



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